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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 904,441	07.12.2001	Jyrki Taipale	71501	9706

22242 7590 11.21.2002

FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER

ZIRKER, DANIEL R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-17 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-17 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit 1771

1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, it is suggested that applicant use "comprising" language instead of "including" terminology to be more in conformance with U.S. practice. Additionally, it is unclear to the Examiner in claim 1 line 2, the phrase "on its one side" since the base sheet is believed to have two sides. In claims 4 and 5 proper Markush language should be utilized and in claim 5 the phrase "other dye-based printing methods" is vague and indefinite. In claim 9 there does not appear to be any method steps recited.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

4. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit 1771

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 7-10, 14 and 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 55129475 Abstract. Note particularly the recitation that one of the substrates of the covering paper 1 can be made of a single-glazed paper which is manufactured by a paper making machine having a Yankee dryer, with the pressure sensitive adhesive (i.e. self-adhesive) being coated onto the surface of the paper. As such, the smoothness of the paper parameter formed by being in contact with the hot drying surface is believed to be, if not either expressly or inherently disclosed, an obvious modification for one of ordinary skill who would be desirous of obtaining the particular surface topology required for utilization. Other parameters that are not either expressly or inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

Art Unit 1771

7. Claims 3-6, 11-13, 15 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP Abstract -475. The reference is again relied upon substantially as set forth above, with such parameters as the ability to be printed on the paper surface (claims 4, 5, 12, 13) are each taught as suitable usages for the formed genus of paper coated adhesive articles. Other parameters that are not either expressly or inherently disclosed are again believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

8. Claims 1-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Labar. The reference discloses (note particularly Figures 1 and 4, column 2 lines 11-29, line 64 - column 3 line 16, column 3 lines 27-40, column 4 lines 4-14, line 63 - column 5 line 1, column 5 lines 36-42, column 6 lines 11-26, the Table) a broad genus of pressure sensitive adhesive coated ~~paper~~<sup>per</sup> laminates whose paper surfaces can in certain embodiments be treated by a Yankee paper machine (e.g. column 4 lines 5+) to obtain the requisite smooth surface. Additionally, such resultant paper articles can be utilized for use in making label type laminates coated with pressure sensitive adhesives (column 2 lines 12-15). As such, the remaining parameters set forth in applicant's claims are each believed to be, if not either expressly or inherently disclosed obvious modifications for one of ordinary skill, in the absence of unexpected results.

Serial No. 09/904,441

-5-

Art Unit 1771

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also the prior art cited in applicant's specification on page 1, as well as the PGP publication of the present invention.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

October 21, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1300~~  
1700

*Daniel Zirker*